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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/491,727	01/27/2000	David M. Austin	AUZ-001 P	8984

7590

08/23/2006

Wesley L Austin esq
1244 E. 1650 S.
Bountiful, UT 84010

EXAMINER

ZIA, SYED

ART UNIT	PAPER NUMBER
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2131

DATE MAILED: 08/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/491,727	AUSTIN ET AL.	
	Examiner	Art Unit	
	Syed Zia	2131	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 May 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) 20-32 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

This office action is in response to amendment filed on May 11, 2006. Original application contained Claims 1-32. Applicant previously amended 1, 16-18, 20, 29, 30, and 31. Claims 1-32 were subject to election/restriction. Applicant elected 1-19 without traverse, and withdrawn Claims 20-32 from prosecution. Therefore, presently pending claims are 1-19.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 18-19 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter

In this case nonfunctional descriptive material is recorded on some computer-readable medium, in a computer or on an electromagnetic carrier signal, it is not statutory since no requisite functionality is present to satisfy the practical application requirement. Also merely claiming nonfunctional descriptive material, i.e., abstract ideas, stored in a computer-readable medium, in a computer, on an electromagnetic carrier signal does not make it statutory. Also, a signal, a form of energy, does not fall within the definitions of manufacture. Thus, a signal does not fall within one of the four statutory classes of § 101. As stated the subject matter of the above noted claims

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refers to a computer program that is not stated as being contained within any tangible medium. In order for such subject matter to conform to the statutory basis it must be contained within a computer readable medium or some other form that is tangible.

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

1. Claims 1-19 of the instant Application No. 09/491727 (hereafter '727) are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-21 of copending Application No. 10/027714 (hereafter '714).

Although the conflicting claims are not identical, they are not patentably distinct from each other because in view of the obviousness type double patenting rationale enunciated in **Georgia-Pacific Corp. v. United States Gypsum Co.**, 195 F.3d 1322, 1326, 52 USPQ2d 1590, 1593 (Fed. Cir. 1999, the instant application's '727 above mentioned claims merely detecting presence of observer program on host devices in network computing environment by comparing

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memory content which is a obvious variation of scanning a host computer for observer program by comparing the memory content in a network environment as claimed in copending application '714.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claim 1-19 are rejected under 35 U.S.C. 102(e) as being anticipated by Coffey et al. (U.S. Publication 2003/0040889 A1). With respect to claim 1, Coffey teaches a system for detecting the presence of an observing program on a computer system, wherein the observing program is programmed to observe a user's activities on the computer system by monitoring user input entered through a user input device and to create data from the observing on the computer

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system, the system including computer software for running on the computer system, the system (Fig.1-5), comprising:

the observer data that includes data descriptive of an observer program, the observer program being programmed to observe a user's activities on the computer system by monitoring user input entered through a user input device and also operating to create log file from the observing of the observer program; and accessing instructions that access the observer data, reading instructions that read memory of the computer system to obtain memory data, comparing instructions that compare the observer data with memory data read in from memory to determine whether the observer program is present on the computer system; generating instructions that generate results from the comparing, wherein the results generated indicate whether the observer program is present on the computer system; and outputting instructions that obtain the results and provide the results for a user (paragraph 0033-0036).

3. Claim 2 is rejected as above in rejecting claim 1, wherein the reading instructions read the memory of the computer system by querying the operating system of the computer system for the tasks running and by examining task information provided by the operating system [paragraph 0037].

4. Claim 3 is rejected as above in rejecting claim 1, wherein the outputting instructions provide the results to a user through a graphical user interface (paragraph 0036).

5. Claim 4 is rejected as above in rejecting claim 1, wherein the reading instructions read the memory of the computer system by querying the file system of the computer system for the

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files located on storage media and by examining file information provided by the file system (paragraph 0033-0034).

6. Claim 5 is rejected as above in rejecting claim 1, wherein the reading instructions read the memory of the computer system by opening a file located on storage media and by examining contents of the file (paragraph 0034).

7. Claim 6 is rejected as above in rejecting claim 1, wherein the observer data includes data descriptive of a plurality of observer programs and wherein the system compares the observer data with the memory data to determine whether any known observer program is present (paragraph 0024-0025).

8. Claim 7 is rejected as above in rejecting claim 1, further comprising countermeasure instructions wherein the countermeasure instructions alter the operation of the observer program (paragraph 0024-0025).

9. Claim 8 is rejected as above in rejecting claim 7, wherein the countermeasure instructions alter the operation of the observer program by altering observer program configuration data (paragraph 0025-0026).

10. Claim 9 is rejected as above in rejecting claim 7, wherein the countermeasure instructions alter the operation of the observer program by altering a file on the computer system (paragraph 0027).

11. Claim 10 is rejected as above in rejecting claim 7, wherein the countermeasure instructions alter the operation of the observer program by altering reporting data generated by the observer program (paragraph 0027).

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12. Claim 11 is rejected as above in rejecting claim 7, wherein the countermeasure instructions alter the operation of the observer program by replacing reporting data generated by the observer program (paragraph 0036).

13. Claim 12 is rejected as above in rejecting claim 7, wherein the countermeasure instructions alter the operation of the observer program by replacing a file of the observer program (paragraph 0038).

14. Claim 13 is rejected as above in rejecting claim 1, wherein the observer data includes data descriptive of observing activity typical of observing programs and wherein the system compares the observer data with the memory data to determine whether any known observer program is present (paragraph 0039).

15. Claim 14 is rejected as above in rejecting claim 1, further comprising the observer data, wherein the observer data includes a list of files and modules that are part of the observer program software, and wherein the reading instructions read the memory of the computer system by querying the operating system of the computer system for the tasks running and by examining task information provided by the operating system, and wherein the reading instructions also read the memory of the computer system by querying the file system of the computer system for the files located on storage media and by examining file information provided by the file system, and wherein the outputting instructions provide the results to a user through a graphical user interface (paragraph 0033-0036).

16. Claim 15 is rejected as above in rejecting claim 1, wherein the system is made available over a computer network through a web site (paragraph 0015).

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17. With respect to claim 16, Coffey teaches a system for detecting the presence of an observing program on a computer system, wherein the observing program is programmed to observe a user's activities on the computer system by monitoring user input entered through a user input device and to create data from the observing on the computer system, the system including computer software for running on the computer system, the system (Fig.1-5), comprising:

observer data that includes data descriptive of an observer program, the observer program being programmed to observe a user's activities on the computer system by monitoring user input entered through a user input device and also operating to create log file from the observing of the observer program; and means for accessing the observer data; means for reading memory of the computer system to obtain memory data, means for comparing the observer data with memory data to determine whether the observer program is present on the computer system; means for generating results from the comparison, wherein the results generated indicate whether the observer program is present on the computer system; and means for outputting the results for a user (paragraph 0033-0036).

18. With respect to claim 17, Coffey teaches a method for detecting the presence of an observing program on a computer system, wherein the observing program is programmed to observe a user's activities on the computer system by monitoring user input entered through a user input device and to create data from the observing on the computer system, the system

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including computer software fro running on the computer system, the system (Fig.1-5), the method comprising the steps of:

accessing observer data, the observer data including data descriptive of an observer program, the observer program being programmed to observe a user's activities on the computer system by monitoring user input entered through a user input device and also operating to create log file from the observing of the observer program; reading memory of the computer system to obtain memory data; comparing the observer data with memory data read in from memory to determine whether the observer program is present on the computer system; generating results from the reading and comparing, wherein the results generated indicate whether the observer program is present on the computer system; and outputting the results for a user (paragraph 0033-0036).

19. With respect to claim 18, Coffey teaches a computer-readable medium containing instructions for detecting the presence of an observing program on a computer system, wherein the observing program is programmed to observe a user's activities on the computer system by monitoring user input entered through a user input device and to create data from the observing on the computer system, wherein the instructions comprise executable instructions for implementing a method (Fig.1-5) comprised of the steps of:

accessing observer data, the observer data including data descriptive of an observer program, the observer program being programmed to observe a user's activities on the computer system by monitoring user input entered through a user input device and also operating to create log file from the observing of the observer program; reading memory of the computer system to

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obtain memory data; comparing the observer data with memory data read in from memory to determine whether the observer program is present on the computer system; generating results from the reading and comparing, wherein the results generated indicate whether the observer program is present on the computer system; and outputting the results for a user (paragraph 0033-0036).

20. Claim 19 is rejected as above in rejecting claim 18, wherein the computer-readable medium is a data transmission medium (0045).

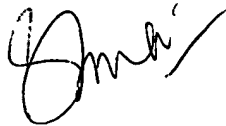
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Syed Zia whose telephone number is 571-272-3798. The examiner can normally be reached on 9:00 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz Sheikh can be reached on 571-272-3795. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

A handwritten signature in black ink, appearing to be 'J. M. Smith' or similar, with a stylized flourish at the end.

SZ

August 16, 2006